



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/608,334

06/30/2003

Dario Bazan Bejarano

MFCP.102772

8771

45809

7590

11/27/2006

SHOOK, HARDY & BACON L.L.P.
(c/o MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER

REZA, MOHAMMAD W

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,334	Applicant(s) BAZAN BEJARANO, DARIO	
	Examiner Mohammad W. Reza	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-62 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 33, and 44-46 are rejected under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts do not meet the requirement of a "useful, concrete and tangible" result to have a practical application. According to the specification (page:1-9) of the present application, **"....negotiation means, the negotiation means for receiving a security authorization request....."** and

“....**negotiation means terminates**.....” does not meet the requirement of a “useful, concrete and tangible” result to have a practical application as well. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process. So, it does not appear that a claim reciting only abstract idea without producing any useful tangible result falls within any of the categories of patentable subject matter set forth in § 101.

2. Claims 49-62 are rejected under 35 U.S.C. 101 because the claim invention is directed to non-statutory subject matter. According to the specification of the invention (Page 1-9) a computer readable medium is reasonably interpreted by one of ordinary skill as just software, it is a system of software, per se. In this claim the function of the program is just software not any hardware. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure **stored** on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure **stored in memory** held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not

Art Unit: 2136

capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer programs claimed as computer instructions per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. So, it does not appear that a claim reciting software with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2136

4. Claims 1, 4, 8-15, 17, 20, 24-31, 33, 36, 40-47, 49, 52, and 56-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Wied et al hereafter Wied (US patent 5828893).

5. As per claim 1, Wied discloses a method comprising: receiving a security authorization request to establish a secure connection between an internal node, the internal node being internal to a security-enabled domain, and an external node, the external node being external to the security-enabled domain (col. 2, lines 15-38, col. 4, lines 3-9); comparing a first protocol set associated with the internal node to a second protocol set associated with the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51); and establishing a secure connection between the external node and the internal node when a matching protocol between the first protocol set and the second protocol set is found (col. 3, lines 23-27, col. 4, lines 12-20, col. 4, lines 21-50).

5. As per claim 4, Wied discloses a method wherein the security-enabled domain comprises a distributed directory domain (col. 2, lines 15-38, col. 4, lines 3-9).

5. As per claim 8, Wied discloses a method wherein the security authorization request is generated by the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51).

5. As per claim 9-10, Wied discloses a method wherein the step of receiving the security authorization request is executed by the internal node, and wherein the security authorization request is generated by the internal node (col. 2, lines 15-38, col. 4, lines 3-9).

5. As per claim 11, Wied discloses a method wherein the step of receiving the security authorization request is executed by the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51).

5. As per claim 12-13, Wied discloses a method comprising a step of terminating the secure connection when a session between the external node and the internal node is complete, and a step of terminating connection processing when no match between the first protocol set and the second protocol set is found (col. 3, lines 23-27, col. 4, lines 12-20, col. 4, lines 21-50).

5. As per claim 14, Wied discloses a method comprising a step of selecting a protocol to use in establishing the secure connection when a plurality of matching protocols are found (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51).

5. As per claim 15, Wied discloses a method comprising a step of authenticating at least one of the internal node and the external node (col. 2, lines 15-38, col. 4, lines 3-9).

5. As per claim 17, Wied discloses a system comprising: a first interface to an internal node, the internal node being internal to a security-enabled domain, the internal node having an associated first protocol set; a second interface to an external node, the external node being external to the security-enabled domain, the external node having an associated second protocol set; and a negotiation engine, the negotiation engine receiving a security authorization request to establish a secure connection between the internal node and the external node (col. 2, lines 15-38, col. 4, lines 3-9), comparing the first protocol set associated with the internal node to the second protocol set associated

Art Unit: 2136

with the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51), and establishing a secure connection between the external node and the internal node when a matching protocol between the first protocol set and the second protocol set is found (col. 3, lines 23-27, col. 4, lines 12-20, col. 4, lines 21-50).

13. Claims 20, 24-31 are listed all the same elements of claim 4, 8-15 but in system form rather than method form. Therefore, the supporting rationales of the rejection to claim 4, 8-15 apply equally as well to claim 20, 24-31.

5. As per claim 33, Wied discloses a system comprising: first interface means for interfacing to an internal node, the internal node being internal to a security-enabled domain, the internal node having an associated first protocol set; second interface means for interfacing to an external node, the external node being external to the security-enabled domain, the external node having an associated second protocol set; and negotiation means, the negotiation means for receiving a security authorization request to establish a secure connection between the internal node and the external node (col. 2, lines 15-38, col. 4, lines 3-9), comparing the first protocol set associated with the internal node to the second protocol set associated with the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51), and establishing a secure connection between the external node and the internal node when a matching protocol between the first protocol set and the second protocol set is found (col. 3, lines 23-27, col. 4, lines 12-20, col. 4, lines 21-50).

13. Claims 36, 40-47 are listed all the same elements of claim 4, 8-15 but in system form rather than method form. Therefore, the supporting rationales of the rejection to claim 4, 8-15 apply equally as well to claim 36, 40-47.

5. As per claim 49, Wied discloses a computer readable medium, comprising: receiving a security authorization request to establish a secure connection between an internal node, the internal node being internal to a security-enabled domain, and an external node, the external node being external to the security-enabled domain (col. 2, lines 15-38, col. 4, lines 3-9); comparing a first protocol set associated with the internal node to a second protocol set associated with the external node (col. 2, lines 40-52, col. 3, lines 15-21, and col. 4, lines 21-51); and establishing a secure connection between the external node and the internal node when a matching protocol between the first protocol set and the second protocol set is found (col. 3, lines 23-27, col. 4, lines 12-20, col. 4, lines 21-50).

13. Claims 52, 56-62 are listed all the same elements of claim 4, 8-15 but in computer readable medium form rather than method form. Therefore, the supporting rationales of the rejection to claim 4, 8-15 apply equally as well to claim 52, 56-62.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3, 5-7, 16, 18-19, 21-23, 32, 34-35, 37-39, 48, 50-51, and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wied et al hereafter Wied (US patent 5828893) in view of Kadyk et al hereafter Kadyk (US Patent application 20020157019).

4. As per claim 2, Wied discloses a method wherein the external node comprises at least one of a computer (col. 2, lines 15-38, col. 4, lines 3-9). He does not explicitly disclose a network-enabled wireless device. However, in the same field of endeavor, Kadyk discloses a network-enabled wireless device (paragraphs, 0053).

Accordingly, it would be obvious to one of ordinary skill in the network security art at the time of invention was made to have incorporated Kadyk's teachings of negotiating secure connections through a proxy server with the teachings of Wied, for the purpose of establishing the secure connection between two nodes in a network and specifically described the external node as a wireless device server node (Kadyk, abstract, summary).

4. As per claim 3, Wied discloses a method wherein the internal node comprises at least one of a client computer (col. 2, lines 15-38, col. 4, lines 3-9). He does not explicitly disclose a server. However, Kadyk discloses a server (paragraphs, 0015). The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 2.

4. As per claim 5-7, Wied does not disclose a method wherein the security-enabled domain comprises a certificate-based domain, wherein the certificate-based domain

Art Unit: 2136

comprises a Kerberos-enabled domain, and protocol comprises an X.509 certificate.

However, Kadyk discloses wherein the security-enabled domain comprises a certificate-based domain, wherein the certificate-based domain comprises a Kerberos-enabled domain, and protocol comprises an X.509 certificate (paragraphs, 0017).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 5-7.

4. As per claim 16, Wied does not disclose a method wherein the step of authenticating comprises communicating a certificate to a certificate authority. However, Kadyk discloses wherein the step of authenticating comprises communicating a certificate to a certificate authority (paragraphs, 0017).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 16.

13. Claims 18-19, 21-23, and 32 are listed all the same elements of claim 2-3, 5-7, and 16 but in system form rather than method form. Therefore, the supporting rationales of the rejection to claim 2-3, 5-7, and 16 apply equally as well to claim 18-19, 21-23, and 32.

13. Claims 34-35, 37-39, and 48 are listed all the same elements of claim 2-3, 5-7, and 16 but in system form rather than method form. Therefore, the supporting rationales of the rejection to claim 2-3, 5-7, and 16 apply equally as well to claim 34-35, 37-39, and 48.

13. Claims 50-51, and 53-55 are listed all the same elements of claim 2-3, 5-7 but in computer readable medium form rather than method form. Therefore, the supporting

Art Unit: 2136

rationales of the rejection to claim 2-3, 5-7, and 16 apply equally as well to claim 34-35, 37-39, and 48.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad w. Reza whose telephone number is 571-272-6590. The examiner can normally be reached on M-F (9:00-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MOAZZAMI NASSER G can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad Wasim Reza

AU 2136

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2101


11/21/06